

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

In Re Ex Parte Application of BAYERISCHE
MOTOREN WERKE AG

Applicant,

For an Order Pursuant to 28 U.S.C. Section
1782 Granting Leave to Obtain Discovery
for Use in Foreign Proceeding.

Case No.

**EX PARTE APPLICATION OF BAYERISCHE MOTOREN WERKE AG FOR AN
ORDER PURSUANT TO 28 U.S.C. SECTION 1782 GRANTING LEAVE TO OBTAIN
DISCOVERY FOR USE IN A FOREIGN PROCEEDING**

Applicant Bayerische Motoren Werke Aktiengesellschaft (“BMW AG,” or “Applicant”) submits this Ex Parte Application for an Order to Obtain Discovery for Use in Foreign Proceedings pursuant to 28 U.S.C. § 1782(a) from Gerald Padian (“Mr. Padian,” or the “Respondent”). BMW AG seeks an order to authorize subpoenas requiring Mr. Padian to provide specific documents and make himself available for a deposition for use in connection with a patent infringement action in Germany, and a corresponding nullity action. The document and deposition subpoenas proposed to be served on Mr. Padian in substantially similar form are attached to this application as Exhibits A and B, respectively. This application is supported by an accompanying Memorandum of Law, the Declaration of Lionel Lavenue (“Lavenue Decl.”), and the Declaration of Prof. Dr. Tilman Müller-Stoy (“Müller-Stoy Decl.”), filed concurrently herewith.

This application is brought on an *ex parte* basis pursuant to Civil L.R. 6.1(d). Courts in the Second Circuit routinely handle §1782 requests on an *ex parte* basis. *In re Hornbeam Corp.*, 2015 U.S. Dist. LEXIS 142361 (S.D.N.Y. 2015), *aff’d*, *Symeou v. Hornbeam Corp. (In re Hornbeam Corp.)*, 722 F. App’x 7 (2d Cir. 2018) (collecting cases, and noting that “[d]istrict courts may and customarily do resolve applications for discovery pursuant to § 1782 through ex parte proceedings” and that there is a “widespread recognition that § 1782 applications are properly handled ex parte”); *see also In re O’Keeffe*, 650 F. App’x 83, 85 (2d Cir. 2016), quoting *Gushlak v. Gushlak*, 486 F. App’x 215 (2d Cir. 2012) (“[I]t is neither uncommon nor improper for district courts to grant applications made pursuant to § 1782 ex parte.”).

Applicant satisfies each of the three statutory requirements set forth in 28 U.S.C. § 1782. First, the Respondent from whom discovery is sought is found within the Southern District of New York. Second, the discovery sought by Applicant is “for use” in an ongoing German proceeding described in accompanying Memorandum of Law and supporting declarations. Third,

Applicant is an interested person within its capacity as a defendant in the ongoing German proceeding.

Further, each of the discretionary factors established in *Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. 241, 264-65 (2004), militate in favor of granting this Application. First, the Respondent from whom discovery is not a participant in the ongoing German proceeding and, as such, this Application constitutes the only practical and timely method for obtaining the needed evidence for use there. Second, there is no indication that the foreign tribunal would be unreceptive to the evidence. Third, the documentary and testimonial evidence sought through the instant Application would likely be admissible in the ongoing German proceeding and does not otherwise circumvent any proof-gathering restriction under the laws of Germany. Fourth, the discovery sought through this Application is not unduly intrusive or burdensome because it is of limited scope. The proposed requests to Respondent seek limited records relating to Respondent's knowledge of the patent Arigna asserts in Germany, the value Mr. Padian, Arigna, and related individuals and entities place on it, and Mr. Padian's involvement and knowledge of Arigna and its funding. This information is relevant to at least BMW AG's accounting, damages, and value-in-dispute defenses in Germany.

Accordingly, for the reasons described in the accompanying Memorandum of Law and supporting declarations, Applicant respectfully requests that the Court issue an Order in the proposed or substantially similar form attached hereto as Exhibit 1 (1) granting judicial assistance pursuant to 28 U.S.C. § 1782, and (2) authorizing Applicant to serve subpoenas including discovery requests in substantially similar form as those attached hereto as Exhibits A and B.

Dated: April 15, 2022

By: 

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